

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RANCE W. SEARLE and MARTY G. HANSON

MAILED

JUL 28 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2006-1428
Application No. 10/669,157
Technology Center [3600]

ON BRIEF

Before BAHR, LEVY, and FETTING, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 4, 5, 7-10 and 13-24, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to container gardening and a planter (specification, page 1).

Claim 1 is representative of the invention, and is reproduced as follows:

A planter for high-density growth of plants comprising:

(a) a first bottom;

(b) a first front wall, a first back wall, and first and second side walls disposed on said first bottom such that said first bottom, first front wall, first back wall, and first and second side walls define a first cavity for receiving a plant growth medium for supporting roots of said plants, wherein said first front wall and first and second side walls comprise a plurality of holes configured for permitting stems of said plants to extend therethrough, and wherein the first bottom, first front wall, or first back wall comprises at least one drain hole for permitting liquids to drain therethrough; and

(c) a first flange disposed on said first side wall configured for permitting attachment of a second bottom, a second front wall, and a second back wall thereto, and a second flange disposed on said second side wall configured for permitting attachment of a third bottom, a third front wall, and a third back wall thereto.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Rolfe et al. (Rolfe)	4,287,997	Sep. 8, 1981
AU 9217076A (Australian Patent)	Khoury	May 29, 1991

Claims 1, 2, 4, 5, 7-10 and 13-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Khoury in view of Rolfe.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (mailed October 14, 2005) for the examiner's complete reasoning in support of the

rejection, and to the brief (filed August 8, 2005) and reply brief (filed December 21, 2005) for the appellants' arguments thereagainst.

Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii) (eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejection advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer. Upon consideration of the record before us, we make the determinations which follow.

We begin with claim 1. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re

Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness.

Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole. See id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745

F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (final rejection, page 2) is that

Khoury is silent on a first flange disposed on the first side wall configured for permitting attachment of a second bottom, a second front wall, and a second back wall thereto, and a second flange disposed on said second side wall configured for permitting attachment of a third bottom, a third front wall, and a third back wall thereto.

To overcome this deficiency of Khoury, the examiner turns to Rolfe for a teaching of a flange on a side wall for attaching additional receptacles. The examiner adds that it would have been obvious to add an additional receptacle as a mere duplication of a known element for a multiple effect performing the same intended function.

Appellants' position (brief, page 13) is that Khoury is not directed to a planter, but rather is directed to a crate. It is argued (brief, page 14) that Rolfe fails to teach or suggest securing or locking together a third container to the two other containers. Appellants further assert (brief, page 15) that Rolfe is non-analogous art because Rolfe is directed to shipping freight, whereas appellants are growing plants in containers. Appellants add (brief, page 16) that "[a] person of ordinary

skill in the art of planters would not reasonably look to the art of freight containers to solve the problem of making planters of a selected length." It is additionally asserted (brief, page 17) that the shipping container of Rolfe is not reasonably pertinent to the problem with which the present inventors were involved.

The examiner responds (answer, page 3) that the crate of Khoury is capable of being used as a planter, and that the intended use of the crate does not structurally distinguish the claimed invention from the prior art. The examiner additionally asserts (answer, page 4) that Rolfe is analogous prior art because it is related to the same field, i.e., containers. It is argued (answer, page 5) that Rolfe teaches flanges on the top and bottom of the container that facilitate attaching and stacking. The examiner (id.) relies upon elements 11, 12 and 13 of Rolfe as teaching flanges on walls of the container that enable attaching multiple containers together at different locations around the first container (i.e. top, side, or bottom).

In the reply brief, appellants argue (reply brief, page 6) to the effect that the examiner's rejection is based on the inappropriate use of hindsight, and that the enclosed container of Rolfe would be inappropriate for use in a planter because the

enclosed container would not permit sunlight to reach the plants and would not permit water to drain from the soil.

From our review of the references, we note at the outset that the agricultural product container of Khoury could be used as a planter because it is a container for agricultural products that contains numerous holes 48. In addition, we find Rolfe to be analogous art because it is directed to the problem of connecting together two containers. From the disclosure of Rolfe of using flange 31 and channel 30 for connecting another container to the first container, we find that an artisan would have been motivated to connect containers together in view of the combined teachings of Khoury and Rolfe.

We additionally agree with the examiner that to add a third container would have been an obvious duplication of elements to an artisan. However, it is at this point that we part company with the examiner. Claim 1 requires that the flanges configured for permitting attachment to second and third back wall, bottom wall are disposed on the sidewalls. From our review of Rolfe, we find that the channel 30 and flange 31 are mounted on a sidewall, but that the flange and channel do not connect to the bottom wall, back wall and front wall, but rather to the sidewall of another container. The support members 11-13 on the bottom of

the container do attach to the top of a lower placed container. However, these support members 11-13, or the similar support members on the top of the container, are not part of the flange disposed on the sidewall. Thus, even if the teachings of the references were combined as advanced by the examiner, the resultant structure would not meet the language of claim 1. Thus, we agree with appellant (reply brief, page 2) that "[i]t is not clear what the combination of Khoury and Rolfe leads to, but it is not the presently claimed planter."

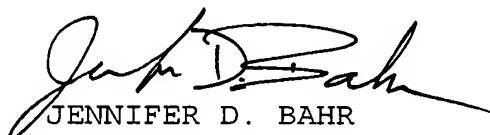
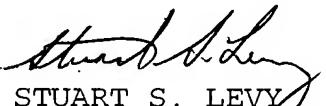
From all of the above, we find that the combined teachings of Khoury and Rolfe would not have suggested to an artisan all of the limitations of claim 1. Accordingly, the rejection of claim 1, and claims 2, 4, 5, 7-10 and 13-15, dependent therefrom, under 35 U.S.C. § 103(a) is reversed.

The other independent claims 16 and 23 contain a similar limitation. Accordingly, the rejection of claims 16 and 23, along with dependent claims 17-22 and 24 under 35 U.S.C. § 103(a) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-, 2, 4, 5, 7-10 and 13-24 under 35 U.S.C. § 103 is reversed.

REVERSED


JENNIFER D. BAHR)
Administrative Patent Judge)
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STUART S. LEVY) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES

ANTON W. FETTING)
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